

## **REMARKS**

### **I. Status of the Claims**

Applicants respectfully thank the Examiner for his withdrawal of the finality of the previous Office Action and his issuance of a new Office Action.

On June 30, 2003, Applicants elected to prosecute claims 1-8. Based on the current Office Action, it is apparent that the Examiner reconsidered the restriction requirement and examined all claims except those cancelled in the Amendment of June 21, 2004. As a result, claims 1-9, 11, 13, and 14 are pending in this application.

Claims 7 and 8 have been amended to delete the phrase "comprising, as a further active compound," and to insert the phrase "wherein said at least one further pharmacologically active compound comprises". Additionally, claim 8 has been amended to include the full spelling of the abbreviated terms. Accordingly, the amendments are supported by the claims and specification as originally filed, and therefore no new matter has been added.

### **II. Summary of Examiner Interview**

Applicants' representative contacted the Examiner on July 6, 2004, and again on July 10, 2004, to discuss the Examiner's rejection of claims 1-9, 11, 13, 14, and 16 in the present Office Action. The Examiner requested the cancellation of claim 7 and the expansion of the abbreviations in claim 8 "to put the claims in a condition for allowance." See Examiner Interview Summary at page 3. At Applicants' request, the Examiner withdrew the finality of the rejection and issued a written Office Action.

## II. Rejection under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 1-9, 11, 13, 14, and 16<sup>1</sup> under 35 U.S.C. § 112, second paragraph, for allegedly “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Office Action at page 3.

During examination of claims for compliance with the definiteness requirement of 35 U.S.C. § 112, second paragraph, the Examiner shall focus on “whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.” M.P.E.P. § 2173.02 (emphasis added). Further, the Examiner shall “allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness.” *Id.* (emphasis original). Therefore, if the language of the claims can reasonably apprise one of ordinary skill in the art of the scope of the claimed invention, any rejection under 35 U.S.C. § 112, second paragraph is improper. See *id.*, §2173.05(b).

In rejecting claim 1, and claims 2-9, 11, 13, and 14 which depend from claim 1, the Examiner requests clarification of what Applicants intend by their recitation of (C<sub>0</sub>-C<sub>30</sub>)-alkylene-(LAG) as one of the substitutions for R1-R6. Specifically, the Examiner inquires as to how a (C<sub>0</sub>-C<sub>30</sub>)-alkylene-(LAG) compound may exist when C<sub>0</sub> is substituted, since “by definition an alkylene group must have at least one carbon.” Office Action at page 3. As Applicants explained to the Examiner during the July 10, 2004 interview, substitution of C<sub>0</sub> into the above formula simply results in a compound

---

<sup>1</sup> Due to the prior cancellation of claim 16 in Applicants’ June 21, 2004, response, Applicants respectfully submit that the current rejection of claim 16 is moot.

without an alkylene-substituted component. In the absence of alkylene substitution, the formula in claim 1 simply defines a LAG molecule, which is defined in the present specification and claims as “a sugar residue, disugar residue, trisugar residue, tetrasugar residue; a sugar acid, an amino sugar; an amino acid residue, an oligopeptide residue comprising 2 to 9 amino acids; or a trialkylammoniumalkyl radical; or -O-O(SO<sub>2</sub>)-OH.” See Specification at page 3; see also claim 1. Accordingly, Applicants respectfully request the rejection of claims 1-9, 11, 13 and 14 be withdrawn.

In rejecting claim 7, the Examiner states that the term “further active compound’ . . . is not indicative of what active compound is intended” and indicated that a structural formula or name is needed. Office Action at page 3. Although in the July 10, 2004, telephonic interview the Examiner requested that claim 7 be canceled, Applicants respectfully assert that in light of the following arguments and amendments, cancellation is not required. Applicants respectfully assert that claim 7 recites that a “further active compound” comprises “one or more compounds that affect lipid metabolism.” Indeed, a more detailed definition is not needed to determine what active compound is intended; rather, one of ordinary skill in the art, armed with the teachings of the present specification and the prior art, could readily determine the specific compound intended by the phrase in a given practical situation. Accordingly, the scope of claims 7 and 8 is clear, and Applicants see no basis that would warrant altering the scope of protection sought by the pending claim. Nevertheless, in the interest of facilitating the prosecution of the present invention, Applicants have amended claims 7 and 8 to recite the full phrase used in claim 6, from which claims 7 and 8 depend.

In rejecting claim 8, the Examiner requests clarification of the abbreviations found in the claim. Specifically, the Examiner requests that Applicants include the "expanded form" of each abbreviation in parenthesis next to the first occurrence of the abbreviation. As with the term "further active compound," discussed above, Applicants assert that, when read in light of the prior art and the specification, one of ordinary skill in the art would easily comprehend the claimed abbreviations and that further definition of the terms is unnecessary. Although Applicants disagree with the Examiner's rejection of claim 8 in light of the included abbreviations, in the interest of advancing prosecution, claim 8 has been amended to further elucidate the abbreviations stated therein.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 23, 2004

By: Carol P. Einaudi  
Carol P. Einaudi  
Reg. No. 32,220